



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,757	03/25/2004	Masanori Hashimoto	FUJY 21.080	5866

26304 7590 09/06/2006
KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER

HUYNH, NAM TRUNG

ART UNIT	PAPER NUMBER
----------	--------------

2617

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/808,757	Applicant(s) HASHIMOTO ET AL.	
	Examiner Nam Huynh	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 21 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/28/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-15 and 21) in the reply filed on 6/16/2006 is acknowledged.

Claims 26 and 27 were not addressed to indicate which group they belong to in the "Requirement for Election/Restriction" filed on 5/31/2006, which has been indicated by the applicant in the reply. Therefore the modified groupings are presented to the applicant as follows:

Group I – Claims 1-15, 21, and 26

Group II – Claims 22-25 and 27

Group III – Claims 16-20

Therefore in accordance to the modified groupings above, this office action will address Group I.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 21, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Masuda et al. (US 2001/0005676).

A. Regarding claim 1, Masuda et al. discloses a radio switching system that comprises the following:

- A Home Location Register (HLR) (registration table) that registers subscriber information of each mobile subscriber (MS) (page 2, paragraph 41).
- A Mobile Switching Center (MSC) (judging and controlling unit) that judges whether a subscriber is inside or outside of a home zone from location information (specific base station) received from the Base Station Controller (BSC) and information from the HLR (page 3, paragraphs 49-51). The MSC also controls the status of the MS by rejecting (incommunicable status) or accepting (communicable status) service (figure 3, items S42, S43).

B. Regarding claim 2, Masuda et al. discloses that the MS makes a location registration request to the MSC. The MSC judges whether the MS is suitable to receive service based upon location information received from the BSC (base station specifying information) and subscriber data (identification information of the terminal) and subscriber information received from the HLR (page 3, paragraphs, 48-56).

C. Regarding claims 21 and 26, Masuda et al. shows in figure 1, multiple base stations (item 4) connected by a communication means to a base station controller (item 3). Furthermore, multiple base station controllers are connected to a MSC (switchboard of a network), which is connected to a HLR (location management apparatus).

Therefore it is inherent that the means of communication between these components can be of any type that is readily known in the art, which includes an Internet Protocol (IP).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al. (US 2001/0005676) in view of Park et al. (US 6,490,455).

Masuda et al. discloses the limitations set forth in claim 1, but does not explicitly disclose that the terminal transmits location updating requests when a location area identifier received from a base station is changed due to an inter-cell movement nor does Masuda et al. disclose the limitations set forth pertaining to the "giving unit". Park et al. discloses a method and apparatus for detecting a mobile phone that registers its location to a mobile switching center when it moves between base stations (column 4, lines 24-28). A signal-generating unit (giving unit) generates a pseudo base station signal including a new zone number, which has not been used in the cellular system (columns 4-5, lines 62-67, 1-10). Therefore it would have been obvious to one of

Art Unit: 2617

ordinary skill in the art at the time the invention was made to implement the handover procedure, as taught by Park et al., in the system of Masuda et al. in order to register the terminal to a base station as the terminal travels to a new area. This added capability would allow the system of Saito et al. to detect the presence of a mobile phone in a state in which the phone is powered up but not performing communications.

Allowable Subject Matter

7. Claims 4-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam Huynh whose telephone number is 571-272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

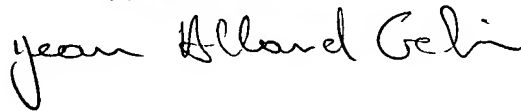
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEAN GELIN
PRIMARY EXAMINER

NTH
8/28/06

A handwritten signature in cursive script that reads "jean Gelin". The signature is written in black ink and is positioned below the printed name and title.